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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/734,592	10/22/1996	ANDREW GOODEARL	CNS-5250.27-	1576

7590 04/20/2004
MARK FARBER
ACORDA THERAPEUTICS, INC.
SIX LANDMARK SQUARE
SUITE 400
STANFORD, CT 06901

EXAMINER

GUCKER, STEPHEN

ART UNIT PAPER NUMBER

1647

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/734,592

Applicant(s)

GOODEARL ET AL.

Examiner

Stephen Gucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 132, 138 and 141-143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 132, 138, 141-143 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/14/02</u> | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Any objections or rejections made in a previous Office Action that are not herein reinstated have been withdrawn.
3. The Examiner would like to thank Applicant for the response to the second request for information under 37 CFR 1.105. It was extremely helpful. To protect Applicant's patent rights should the instant Application be allowed and proceed to issue, Applicant should update the information previously provided when new Applications are filed pertaining to similar subject matter in this Application family.
4. Claims 132, 138, and 141-143 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 91-103 and 108-110 of co-pending U.S. Application No. 08/468,731. Although the conflicting claims are not identical, they are not patentably distinct from each other because the polypeptides administered by the process steps recited in the instant Application for a method of inducing acetylcholine receptor synthesis in a cell by administering an amino acid sequence encoded by SEQ ID NOS:155-159, or an amino acid sequence provided in SEQ ID NOS:152, are polypeptides which are identical to the polypeptides administered in the co-pending Application (SEQ ID NOS:152, 415-419, and nucleotide sequence SEQ ID NO:150 (amino acids 54-103 encoded by nucleotides 161-310 of

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SEQ ID NO:150)) which recites methods of increasing myotube formation, myotube survival, or induction of a muscle developmental program, all of which are inherent features or outcomes that result from the identical process steps of the administration of the same polypeptides in the instant Application.

5. Claims 132, 138, and 141-143 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of co-pending U.S. Application No. 09/530,884. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending claim recites the administration of polypeptides (encoded by SEQ ID NOS:49 and 51) for treating a mammal suffering from *or susceptible to stroke, brain or spinal cord injury or ischemia, or heart attack*, and these administered polypeptides comprise the polypeptide fragments administered in the instant Application. The co-pending claim is a sub-genus of the instant claims because it recites a genus that is smaller than the instant genus, but completely encompassed by the claimed instant genus. Therefore, a species-genus relationship exists between the patented claim and the instant claims, and the patented claim renders the instant claims obvious because the patented claim anticipates the instant claims and the patented species or sub-genus renders the instant genus claims obvious. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

6. No claim is allowed.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. It is Applicant's responsibility and duty to disclose any co-pending applications that present double-patenting issues before the Office at the earliest possible time during prosecution, and it is Applicant's duty to maintain distinct lines of demarcation between the inventions of co-pending Applications. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center 1600 general number which is (571) 272-1600.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday to Friday from 0930 to 1800. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887. The fax phone number for this Group is currently (703) 872-9306.

SG

Stephen Gucker

April 16, 2004


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600